

Appl. No. : 09/919,758  
Filed : July 31, 2001

Applicants submit that some of the method claims of groups II and III are generic to the claims of Group I. Note, for example, that Claim 1 in one respect differs from Claim 21, in that Claim 1 further requires the provision of a promoter-containing sequence and a terminator-containing sequence, while Claim 21 is not limited to the addition of a promoter and/or terminator containing sequences.

Also, some of starting materials of the claims of Groups II and III are generic to the starting materials for the claims of Group I. For example, Claim 1 provides sequences that include regions of complementarity to the first and second regions of complementarity on the second DNA fragment. As noted above, the sequences also include a promoter-containing sequence and a terminator-containing sequence. Claim 21 similarly includes third and fourth nucleic acid fragments that respectively comprise a region complementary to regions on an intermediate fragment (without necessarily including promoter-containing and/or terminator-containing sequences).

Furthermore, the claims of Groups II and III may well be narrowed during prosecution to have a similar scope to the claims of Group I. For example, if dependent Claim 29 in Group III were amended to include the limitations of Claim 21, it would be very similar in some respects to Claim 1. Therefore, examination of the claims of Group I would inevitably require examination of the subject matter of the more generic claims of Groups II and III. (Nothing herein shall constitute a representation that the aforementioned claims differ only in the recited limitations.)

Further, examination of the claims of Groups I-III together would result in a minimal burden on the Office. Again, as discussed above, examination of the claims of Group I would inevitably require examining the subject matter of the more generic claims of Groups II and III, and vice versa, thereby minimizing the burden on the Office. Also, as noted in the Office Action, the claims of Groups I-III are all classified in class 435 and subclass 91 (Group I in subclass 91.52 and Groups II and III in subclass 91.2). Therefore, examination of the claims of Groups I-III together would result in little or no burden on the Office.

## CONCLUSION

In light of the above remarks, reconsideration and withdrawal of the Restriction Requirement is specifically requested. If the Examiner finds any remaining issues that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

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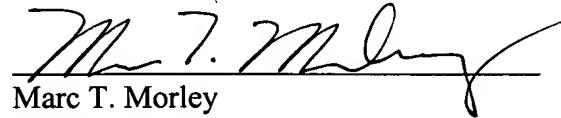
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2/21/03

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